

Appl. No. 10/080,749
Amdt. dated October 1, 2004
Reply to Notice of Non-Compliant Amendment of September 28, 2004

REMARKS

Claims 29-32 and 38-47 previously were pending in the application.

Claims 45-47 were withdrawn by the Examiner and are indicated as withdrawn in the listing of claims.

New claims 48-52 have been added.

The Examiner objected to claims 38-41 and 44 as being in improper form. The typos in those claims have been corrected to better call out the method claims upon which they depend. This amendment is not substantive and is not in response to a substantive rejection. With this correction it is believed the Examiner's objection is fully addressed.

The Examiner also objected to claims 29-32 and 38-44 under 35 U.S.C. § 112, first paragraph. It is respectfully submitted that the Examiner is incorrect as to the reasoning or basis of the amendment regarding without photochemical treatment. It was improper to cross-reference a pending application that is not a part of the file history of the present application. In fact, the claims were amended via a preliminary amendment prior to a first substantive office action and accordingly there is no implication of a response to prior art cited in the present file history. As to the substance of the rejection, it respectfully is submitted that the Examiner is making a requirement of proving the absence of something in the specification. Photochemical treatment is not required in the process specified in the specification. Accordingly it clearly is within the scope of the specification to state in the claim that photochemical treatment is not used. Further support in the specification is found in the Examples provided in the specification,

Appl. No. 10/080,749

Amdt. dated October 1, 2004

Reply to Notice of Non-Compliant Amendment of September 28, 2004

which do not require a photochemical treatment to achieve the bonding properties achieved in the present invention. The present invention utilizes, among other things, specified pH levels and molecular weights to achieve results without resort to photochemical treatments. Accordingly it is respectfully submitted that the rejection under § 112 is traversed.

The Examiner rejected claims 29, 32, 41 and 44 under 35 U.S.C. § 102(e) as anticipated by pending U.S. Application US2002/0087123A1 of Hossainy. The Examiner also rejected claims 29, 30, 41 and 44 under 35 U.S.C. § 102(e) as anticipated by Burns U.S. Patent 6,294,202B1. Rejections under § 103(a) in view of these references were also made, i.e. claims 30-31, 38-40 and 42-43 over Hossainy, claims 38-40 over Burns, and claims 38-39 over either Hossainy or Burns in view of Shah. These bases of rejection respectfully are traversed as follows. One aspect of the present patent application is that enhanced bonding is achieved via reducing the pH of the solutions. For example and without limitation, at reduced pH levels hyaluronic acid can change from a polyelectrolyte to a neutral polymer. Also as a further example, an increase in rotational freedom can occur such as due to molecular expansion and increased intramolecular rotation. By way of further example, at further pH reductions, such as below pH 3.0, electrostatic interaction effects are suppressed. Thus at the reduced pH of these examples or others, enhanced adsorption of the hyaluronic acid to a surface is achieved. These features of achieving enhanced bonding properties using a reduced pH processing or solution are not taught or suggested in either the Hossainy or Burns references. Claims 29, 30 and 32 have

Appl. No. 10/080,749
Amdt. dated October 1, 2004
Reply to Notice of Non-Compliant Amendment of September 28, 2004

been amended to better clarify this property. Accordingly the rejections in view of Hossainy and Burns have been traversed.

New claims 50 and 51 highlight the added benefits of sodium chloride treatment, providing further grounds for patentability.

It is believed that no additional fee is required for the new claims. However, should there be a deficiency of fees, the Commissioner is authorized to charge our deposit account No. 50-2298, in the name of Luce, Forward, Hamilton & Scripps.

Respectfully submitted,

10/1/04
Date



Mitchell P. Brook
Attorney for Applicant(s)
Reg. No. 32,967
c/o LUCE, FORWARD, HAMILTON
& SCRIPPS LLP
11988 El Camino Real, Ste. 200
San Diego, California 92130
Telephone No.: (858) 720-6300

2004022.1